

REMARKS

Claims 1-10, 13-15, 17-19 and 44-47 are pending in this application. In the Board's decision dated May 21, 2004, the Board affirmed the Examiner's rejections of claims 1-10, 13-15, 17 and 44-47 but reversed the Examiner's rejection of claims 18 and 19. After amendment, cancellation and addition of claims herein, claims 1-10, 13-15, 17-19 and 44-47 will still be pending in this application. Reconsideration of this application in view of the amendments above and the following remarks is respectfully requested.

The Board's Decision on Appeal

On May 21, 2004, the Board affirmed the Examiner's rejections of claims 1-10, 13-15, 17 and 44-47 under 35 U.S.C. § 103 but reversed the Examiner's rejection of claims 18 and 19 under 35 U.S.C. § 103.

In their Appeal Brief and Reply Brief, Applicants' argued that the prior art describes "the known problem of programs that take operations on other files within the user's operating system" but does not disclose a module attached to a document for deleting the very document or e-mail to which it is attached, based upon the preselected expiration date or condition.

In affirming the Examiner's rejection of independent claim 1, the Board stated that the "claimed invention is not limited to 'selective' deletion and deletion of 'only' the file to which it is attached." The Board found that it would have been obvious "that a Trojan horse type virus that deletes or overwrites data stored on a user's computer would have eventually overwritten the document or e-mail to which the executable file was attached while carrying out its destruction." See Decision on Appeal, page 7. The Board further stated that:

Here, we do not find that appellants' independent claim 1 is limited to the selective deletion of only the file to which the executable file is attached and therefore the ordinary Trojan horse-type virus using time as an initiator would have suggested the claimed invention as recited in independent claim 1.

See Decision on Appeal, page 9.

In affirming the Examiner's rejection of independent claims 6 and 17, the Board stated:

This Trojan horse-type virus would have either erased data or duplicated itself throughout the storage system as is [sic, it] continued to perform its destruction thereby deleting the e-mail to which it was attached and/or crashing the storage system thereby deleting all data from the storage system. See Decision on Appeal, page 12.

The Board further stated that "a Trojan horse virus, although not specifically tailored as appellants also employ in their first embodiment, would have deleted the e-mail or document to which the executable module was attached." See Decision on Appeal, pages 13-14.

In affirming the Examiner's rejections of dependent claims 5 and 13, the Board found that "these viruses will ultimately damage or delete the document or e-mail to which the executable module is attached, and the language of the claims does not preclude damage or deletion of other documents or e-mails." See Decision on Appeal, page 15.

In reversing the Examiner's rejections of claims 18 and 19, the Board stated that the Examiner merely grouped these claims as having the same limitations as recited in claims 1-5, but "clearly they are not the same." The Board continued that the Examiner briefly cited to Beck at column 7 as teaching encryption and decryption, but did not address the specific limitations of claims 18 and 19.

Amendment of Claims 1, 6 and 17

In accordance with the Board's affirmance of the Examiner's rejections of claims 1, 6 and 17, Applicants herein amend claims 1, 6 and 17 to add the word "only" to each claim within the clause relating to the deletion of the document or e-mail message by the executable module attached to it.

As discussed above, the Board sustained the Examiner's rejections because a Trojan horse type virus, while carrying out its destruction, would have eventually overwritten the document or e-mail to which it was attached. According to the Board, the claims were not limited to selective deletion of only the document or e-mail to which the executable module is

attached. These amendments are being made in order to claim that the invention is directed and limited to the selective deletion of only the document or e-mail message to which the executable module is attached. Applicants submit that these amendments squarely address the Board's concerns, and Applicants respectfully request that the Examiner pass the amended claims to allowance.

Amendment of Claims 18 and 19

In accordance with the Board's reversal of the Examiner's rejections of claims 18 and 19, Applicants herein amend claims 18 and 19 to place them into independent form by incorporating the limitations of their base claims 1 and 6, respectively. These amendments are merely matters of form that do not raise new issues or require further consideration or search. Inasmuch as the Board has reversed the Examiner's rejection of these claims, and these claims would be allowable but for their dependency from rejected base claims, Applicants have amended these claims to put them into independent form, including all the limitations of their base claims. Thus, claims 18 and 19 are now allowable, and Applicants request that the Examiner pass them to allowance.

Comment Regarding Amendments

In the event that the Examiner cannot enter all the amendments made herein, the Examiner is urged to enter the amendments that are acceptable and not to enter the amendments that are not acceptable.

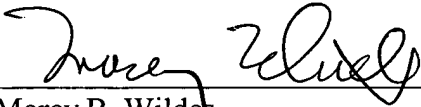
Conclusion

Reconsideration of the present application, as amended, is requested. If, upon review, the Examiner is unable to issue an immediate Notice of Allowance, the Examiner is respectfully requested to telephone Applicant's undersigned attorney in order to resolve any outstanding issues and advance the prosecution of the case.

An early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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